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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,431	12/13/2001	Christopher M. Benson	9903	5732

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EXAMINER

LE, DANH C

ART UNIT PAPER NUMBER

2683

DATE MAILED: 06/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/015,431

Applicant(s)

BENSON, CHRISTOPHER M.

Examiner

DANH C. LE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1, 2, 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato (US 2001/0014870) in view of Aw (US 5,150,127).

As to claim 1, Saito teaches a method of providing an advertisement for a store to a prospective customer (figure 1) comprising the steps of:

compiling an advertisement (a cryptographic, figure 4, processing unit 206 and paragraph 0085 for carry out cryptographic processing regarding the electronic coupon);

formatting the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer, the personal device having a radio receiver enabled to receive the transmission protocol signal (paragraph 128-130, the radio base station 102 in figure 1, first transmits a display format inquiry message for inquiring which display contents description format can be displayed on a display screen of the portable terminal 105, to the portable terminal 105); and

transmitting the radio signal from the store to be received by a personal device (paragraph 128-130).

Sato fails to teach a signal strength is sufficient receiving from the source of the transmission. Aw teaches a signal strength is sufficient receiving from the source of the transmission (col.4, lines 33-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Aw into the system of Sato in order to avoid the loss in signal strength.

As to claim 2, Saito teaches the method of claim 1, wherein the step of transmitting the radio signal from the store includes transmitting the radio signal from the store to within a perimeter of the store (paragraph 0054, 0055, 0058).

As to claim 5, Saito teaches the method of claim 1, wherein the step of formatting utilizes Bluetooth radio transmission protocol, and the radio receiver of the personal device is Bluetooth enabled (paragraph 60).

2. Claims 3, 4, 7-11, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito and Aw in view of Waters (US 2002/0008626).

As to claim 3, the combination of Saito and Aw teaches the method of claim 2, wherein the step of transmitting the radio signal from the store to within a perimeter.

The combination of Saito and Aw teaches fails to teach the perimeter is outside of the store. Waters teaches the perimeter is outside of the store (figure 1, zone 15, col.6, lines 39-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Waters into the system of Saito and Aw in order to transmit an advertising display intended for tourist and motorists outside the store (as suggested by Waters at column 6, lines 39-54).

As to claim 4, the limitation of the claim is the same limitation of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 7, Saito teaches an apparatus for providing an advertisement to a prospective customer (figure 4) comprising:

a storage device operative to store an advertisement (figure 4, 205);

a transmitter in communication with the storage device and operative to receive the advertisement from the storage device, the transmitter further operative to format the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer having a radio receiver enabled to receive the transmission protocol signal (figure 4 and paragraph 128-130, "the radio base station 102 first transmits a display format inquiry message for inquiring which display contents description format can be displayed on a display screen of the portable terminal 105, to the portable terminal 105"); and

Saito fails to teach an antenna in communication with the transmitter and operative to transmit the radio signal from the store. Waters teaches an antenna in communication with the transmitter and operative to transmit the radio signal from the store (figure 2, 14 with antenna symbol). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Waters into the system of Saito in order to send electronic coupon to the mobile inside and outside the store.

As to claim 8, Saito teaches the apparatus of claim 7, wherein the transmitter and antenna are operative to transmit the radio signal from the store to within a perimeter of the store (paragraph 58).

As to claim 9, the limitation of the claim is the same limitation of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 10, the combination of Sato, Aw and Waters teaches the apparatus of claim 8, wherein the transmitter and antenna are operative to transmit the radio signal to an area outside of the store (figure 1, zone 15, col.6, lines 39-54).

As to claim 11, Saito teaches the method of claim 1, wherein the step of formatting utilizes Bluetooth radio transmission protocol, and the radio receiver of the personal device is Bluetooth enabled (paragraph 60).

As to claim 13, Saito teaches the system for store advertising (figure 4) comprising:

a storage device operative to store a store advertisement (figure 4, 205);

a transmitter located at the store and in communication with the storage device and operative to receive the advertisement from the storage device, the transmitter further operative to format the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer having a radio receiver enabled to receive the transmission protocol signal (paragraph 128-129).

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a receiver located at the store and operative to receive an incoming radio signal of the radio transmission protocol from the personal device of the prospective customer (figure 2, 121 and paragraph 66), and

Saito fails to teach an antenna located at the store and in communication with the transmitter and the receiver, the antenna operative to transmit the radio signal from the store and receive the incoming radio signal from the personal device. Waters teaches an antenna located at the store and in communication with the transmitter and the receiver, the antenna operative to transmit the radio signal from the store and receive the incoming radio signal from the personal device (figure 1 and 2, 14 with antenna symbol).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Waters into the system of Saito in order to increase the coverage area and send electronic coupon to the mobile inside the store at the same time to the tourist and motorist outside the store.

As to claim 14, the limitation of the claim is the same limitation of claim 8; therefore, the claim is interpreted and rejected as set forth as claim 8.

As to claim 15, the limitation of the claim is the same limitation of claim 3; therefore, the claim is interpreted and rejected as set forth as claim 3.

As to claim 16, the limitation of the claim is the same limitation of claim 10; therefore, the claim is interpreted and rejected as set forth as claim 10.

As to claim 17, Saito teaches the method of claim 1, wherein the step of formatting utilizes Bluetooth radio transmission protocol, and the radio receiver of the personal device is Bluetooth enabled (paragraph 60).

As to claim 19, Sato teaches a system for store advertising (figure 4) comprising:

a storage device operative to store a store advertisement (figure 4, 205);

a transmitter in communication with the storage device and operative to receive the advertisement from the storage device, the transmitter further operative to format the advertisement into a radio signal having a radio transmission protocol that is receivable by a personal device of a prospective customer having a radio receiver enabled to receive the transmission protocol signal;

Sato fails to teach an antenna located at or about a position proximate to the store and in communication with the transmitter and the receiver, the antenna operative to transmit the radio signal with a signal strength sufficient to be received by a personal device that is greater than 15 meters removed from the antenna. Waters teaches an antenna located at the store and in communication with the transmitter and the receiver, the antenna operative to transmit the radio signal from the store and receive the incoming radio signal from the personal device (figure 1 and 2, 14 with antenna symbol). Aw teaches a signal strength is sufficient receiving from the source of the transmission (col.4, lines 33-51). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Aw and Waters into the system of Sato in order to avoid the loss in signal strength.

As to claim 20, the combination of Sato, Aw and Waters teaches operative to transmit the radio signal to a perimeter that is greater than about 50 meters from the antenna (Aw, 60 feet).

The system of claim 19, wherein the transmitter and antenna are

3. Claims 6, 12, 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito and Aw in view of Treyz et al (US 6,587,835).

As to claim 6, Saito and Aw teaches the method of claim 5, Saito fails to teach the step of formatting includes the step of providing an interactive component to the radio signal. Treyz teaches the step of formatting includes the step of providing an interactive component to the radio signal (col.66, lines 55-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Treyz into the system of Saito and Aw in order to select the advertisement and responding to on-screen options on the handheld ((as suggested by Treyz at column 66, lines 55-67).

As to claim 12, the limitation of the claim is the same limitation of claim 6; therefore, the claim is interpreted and rejected as set forth as claim 6.

As to claim 18, the limitation of the claim is the same limitation of claim 6; therefore, the claim is interpreted and rejected as set forth as claim 6.

4. Claims 3, 4, 7-11, 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito, Aw and Waters in view of McGlade (US 5,327,230).

As to claim 21, the combination of Sato, Aw and Waters teaches the system of claim 19, further operative to transmit the radio signal to a perimeter that is about 50

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meters from the antenna. The combination of Sato, Aw and Waters fails to teach a distance is about 100 meters from the antenna. McGlade teaches a distance is about 100 meters from the antenna (col.12, lines 44-63). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Aw and Waters into the system of Sato in order to avoid the loss in signal strength.

As to claim 22, the combination of Sato, Aw and Waters teaches the system of claim 21, wherein the perimeter comprises an area within the store and an area outside of the store (Waters, figure 1, zone 15, col.6, lines 39-54).

Response to Arguments

Applicant's arguments with respect to claims 1-6, 19-22 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 4/18/05 with claims 7-18 have been fully considered but they are not persuasive.

On discussion regarding patentability of claim 7, the applicant argues that there is no motivate for the proposed modification.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*

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Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applicant argues that a modification results in loss of the ability to track customers within the store, the Examiner disagrees with the applicant's argument since Sato teaches ability to track customers within the store by arranging the radio base station at the prime location such as doorway, register and drinks (paragraph 234, 245, 259) and Waters teaches an antenna in communication with the transmitter and operative to transmit the radio signal from the store (figure 2, 14 with antenna symbol). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Waters into the system of Saito in order to send electronic coupon to the mobile inside and outside the store.

On discussion regarding patentability of claim 7, the applicant argues that Watters has been a mischaracterized which does not transmit a radio signal with formatted advertisement.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

On discussion regarding patentability of claim 7, the applicant argues the rationale supporting modification is not convincing.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the applicant argues that Sato transmits the coupons to the customers as they enter a store, the Examiner disagrees with applicant's argument the base station is installed inside the store such as doorway, registers, drinks (paragraph 259) which transmits the coupons to the customers inside the store and . Waters teaches an antenna located at the store and in communication with the transmitter and the receiver, the antenna operative to transmit the radio signal from the store and receive the incoming radio signal from the personal device (figure 1 and 2, 14 with antenna symbol). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Waters into the system of Saito in order to increase the coverage area and send electronic coupon to the mobile inside the store at the same time to the tourist and motorist outside the store.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANH C. LE whose telephone number is 571-272-7868. The examiner can normally be reached on 8:00AM-5:00PM.

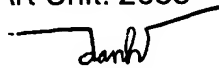
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WILLIAM TROST can be reached on 571-272-7872. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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June 16, 2005

DANH CONG LE
PATENT EXAMINER



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SUPERVISORY PATENT EXAMINER
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